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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,496	04/25/2001	Mark Ashby	032005-092	9267
7590	04/30/2004		EXAMINER	
ROBERT E. KREBS THELEN REID & PRIEST LLP P.O. BOX 640640 SAN JOSE, CA 95164-0640			DRUAN, THOMAS J	
			ART UNIT	PAPER NUMBER
			3724	
			DATE MAILED: 04/30/2004	

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/843,496	ASHBY ET AL.	
	<b>Examiner</b> Thomas J. Druan, Jr.	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 February 2004.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 11,12,14-17 and 27 is/are pending in the application.  
 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 11,12,17 and 27 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

#### **DETAILED ACTION**

1. This action is in response to Applicant's amendment received on 06 February 2004. It is noted that claims 18-26 were cancelled in the amendment of 09 June 2003, but are listed as "Withdrawn" while they should be labeled --Canceled-- in the Amendment filed 06 February 2004. Also, claims 14-16 are withdrawn from consideration as being drawn to a non-elected invention, but are listed in the Amendment filed 06 February 2004 as being "Original" when they should be labeled --Withdrawn--. Please see 37 CFR 1.121 (c).

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the embodiment wherein the flap has a ridge according to claim 27 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 27 refers to the flap as having a ridge; however, there is no support for this limitation in the specification as originally filed. It is noted that while there is a ridge 94 present on the rails 92 as seen in Figure 9, there is no ridge present on the flap 90 itself, nor is there a ridge present on the flap 60 of the elected embodiment depicted in Figure 4. The specification does not consider the feature of a ridge on a flap, and it is therefore deemed to be new matter.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

6. Claims 11, 12, 17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones in view of US 3,315,753 to Cragg et al. (hereinafter Cragg '753) and US 4,573,576 to Krol.

Jones discloses the invention substantially as claimed, including a cutting device comprising: a base 24 having a guide edge 27 and an opening 26 with cutting edges; and a generally triangular flap 22 articulated with respect to the base, the flap having a shape corresponding to the opening and cutting edges corresponding to the cutting

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edges of the opening. Jones does not disclose the cutting device mounted on a card that supports a medical device system for delivering a foam material. Cragg '753 teaches including a device 108 used for cutting foam material in a kit including a medical device system for delivering a foam material, which allows tools used together to be available in a convenient manner. Therefore, it would have been obvious to include the cutter of Jones with a kit including a medical device for delivering a foam material since it would allow tools used together to be conveniently available.

Though Figure 1 of Cragg '753 appears to show a kit as being mounted on a card, there is no support for a card in the specification; however, Krol teaches mounting a kit on a card to provide easy access to the tools within the kit. Therefore, it would have been obvious that the kit of Jones in view of Cragg '753 be mounted on a card to provide easy access to the tools of the kit.

Jones does not disclose a ridge on the flap of Jones. Cragg '753 teaches the use of a ridge 140 on a cutting tool 136 to crease a piece of foam material as it comes in contact with the foam material during a cutting operation in order to aid in folding the foam material to fit inside of a medical foam material delivery system. Therefore, it would have been obvious to one skilled in the art at the time of the invention to add a ridge to the flap of Jones in order to for a crease in a piece of foam material during a cutting operation.

***Response to Arguments***

7. Applicant's arguments filed 06 February 2004 have been fully considered but they are not persuasive. Applicant contends that combining the references to Jones with Cragg '753 or Krol is an impermissible use of hindsight due to the divergent subject matter of Jones and Cragg '753 or Krol. Also, Applicant claims that there would be no motivation to mount the card cutter of Jones on a card that supports a medical device because it would not allow for ease of operation of the card cutter.

8. Applicant's remarks are well taken; however, it is the Examiner's position that the references make obvious the claimed invention. Jones discloses a cutting device for sheet material. Cragg '753 discloses a cutting device for cutting a sheet of foam material, the product of the cutting device being a piece of foam material to be used in a medical delivery device. Cragg '753 teaches the combination of a cutter for sheet material and a medical device for delivering the product cut from the sheet material. Krol teaches mounting a medical kit onto a card to facilitate access to the different pieces of the kit. One skilled in the art at the time of the invention would look to cutters of sheet material when contemplating devices capable of cutting a sheet of foam material, and as such the subject matters of Jones and Cragg '753 intersect. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include

knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As to the difficulty of using the Jones reference while mounted on a card, that may or may not be true; however, there is no reason why the cutting device of Jones cannot be removed from the card to perform the cutting operation. In fact, most devices mounted to a card must be removed to be used.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Druan, Jr. whose telephone number is 703-308-4200. The examiner can normally be reached on M-F (8:30-6:00) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*agpq*  
tjd  
April 22, 2004



BOYER ASHLEY  
PRIMARY EXAMINER